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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,266	03/21/2001	Binnur Al-Kazily	M-9529 US'	3951

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CLARK, ISAAC R

ART UNIT PAPER NUMBER

2154

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

09/814,266

Applicant(s)

AL-KAZILY ET AL.

Examiner

Isaac R Clark

Art Unit

2154

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01/24/2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1,3,4,6-11,13, 14, 16-26, 29-37.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

LARRY D. DONAGHUE
PRIMARY EXAMINER

DETAILED ACTION

Response to Amendment

1. Applicants' arguments filed 01/24/2005 have been fully considered but they are not persuasive.
2. The rejections of claims under 35 USC 112, second paragraph is withdrawn in view of the Applicants' amendment.
3. The applicants make the following arguments:
 - a. Vange (US Published Application No. 2002/0007404) while anticipating determining the contents of a cache says nothing concerning determining whether an online service is downloadable.
 - b. Toulboul (US Patent 6,804,780) fails to teach determining that a service is downloadable by teach checking a service cache record for a service ID associated with a requested online service and considering the service not to be downloadable if the record is not present. Applicant argues that Toulboul instead discloses considering the service to be downloadable if the record is not present.
4. The examiner respectfully traverses each of these arguments.
5. With respect to point (a) Vange discloses providing explicit instructions indicating what material is to be cached including providing site owner specified rules concerning what is to be cached (Paragraph 0068). Vange also discloses that the site owner specified rules may include instructions to obey caching instructions included in HTTP headers which can include designating material as uncacheable (Paragraph 0025).

Art Unit: 2154

These disclosures clearly describe determining whether online content is downloadable to the cache.

6. With respect to point (b), the examiner agrees with the applicants description of the explicit disclosure of Toulboul, but disagrees that the disclosures do not teach determining that a service is downloadable by teach checking a service cache record for a service ID associated with a requested online service and considering the service not to be downloadable if the record is not present. It is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. As applicants' remarks acknowledge, Toulboul teaches maintaining a list keyed to an ID of the content of items not to be downloaded as undesirable for security reasons. One of ordinary skill in the art would recognize that maintaining a list of content not to be downloaded and downloading only material not listed is equivalent to maintaining a list of content that is to be downloaded and avoiding downloading content not found in the list. One of ordinary skill in the art would chose the implementation which was most efficient in a particular case and in a case where the list could most efficiently be completely expressed in terms of content to be downloaded rather than content to avoid downloading would implement the list in that fashion.

LARRY D. DONAGHUE
PRIMARY EXAMINER

